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EXAMINER

PATEL, HEMANT SHANTILAL

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/788,620	<b>Applicant(s)</b> SUN ET AL.	
	<b>Examiner</b> HEMANT PATEL	<b>Art Unit</b> 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 13 objected to because of the following informalities: The “.” At the end of limitation c) ends the claim after this limitation and limitations d)-h) are meaningless. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Independent claim 1 and dependent claims 4, 5 recite "telephone network/internet domain". It is not clear if it is meant to be “telephone network and internet domain” or “telephone network or internet domain”.
3. Claims 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim 13 recites "network interruption/service failure". It is not clear if it is meant to be “network interruption and service failure” or “network interruption or service failure”.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lamb (US Patent No. 6,747,970 B1).

***Regarding claim 1***, Lamb teaches of a method of providing communication between a telephone caller and a callee of the telephone call, comprising:

a) linking a switched telephone network with an internet network via a telephone network/internet domain network interface (Figs. 3-4 items 205-1, 202-203, 205-2);

b) detecting an attempted call within the switched telephone network (col. 33 ll. 58-col. 34 ll. 13 call from the caller with destination identifier);

c) upon detection of the attempted call, having the switched telephone network inform the telephone network/internet domain network interface (col. 34 ll. 4-13 message to telecommunication hosting server 203) to provide a message reporting details of the attempted call to the callee via the internet network (Figs 3-4; col. 34 ll. 13-23 to provide a message that reports details of the attempted call to the callee via the internet network col. 27 ll. 18-20 IP-based connectionless network interface to Internet

200 to a user agent col. 34 ll. 24-col. 35 ll. 40; col. 51 ll. 11-41 sending Instant Message to the callee) (Figs. 3-5, 7-8, 11-12 and their descriptions).

**Regarding claim 2**, Lamb teaches of the method, wherein the switched telephone network is a public switched telephone network (Fig. 3 item 101).

**Regarding claim 3**, Lamb teaches of the method, wherein the internet network is the public Internet (Fig. 3 item 200).

**Regarding claim 4**, Lamb teaches of the method, wherein the public switched telephone network informs the telephone network/internet domain network interface to provide the message via an Internet protocol to the callee of the public switched telephone network call when an abnormality is detected in the public switched telephone network which prevents the public switched telephone network from completing the call connection between the caller and the callee (Col. 57 ll. 32-col. 58 ll. 37; PSTN informing about the abnormality i.e. the status of callee device as un-functional col. 58 ll. 6-14; col. 51 ll. 11-41 user agent on a Internet network using Internet protocol to send instant message).

**Regarding claim 6**, Lamb teaches of the method, wherein the callee informs at least **one of** the public switched telephone network **or the Internet domain network interface** to provide the message to the callee in real time via an Internet protocol when the attempted call is intended for the telephone number of the callee (col. 59 ll. 3-col. 60 ll. 18 user informing where and how, he or she can be reached).

**Regarding claim 7**, Lamb teaches of the method, wherein the message details at least **one of the telephone number trying to reach the callee (destination identifier)**,

*the caller identification of the telephone number trying to reach the callee (caller-id), and the time of the attempted call (col. 34 ll. 1-23; col. 50 ll. 2-15).*

**Regarding claim 8,** Lamb teaches of the method, wherein the message is an Instant Message provided in real time (col. 51 ll. 11-41 sending Instant Message to the callee).

**Regarding claim 9,** Lamb teaches of the method, wherein the message is a text message (col. 51 ll. 11-41 sending Instant Message to the callee).

**Regarding claim 10,** Lamb teaches of the method, wherein the message is a text message (col. 51 ll. 11-41 sending email to the callee).

**Regarding claim 11,** Lamb teaches of a method of providing communication between a telephone caller and a callee of the telephone call, comprising:

a) linking a public switched telephone network with an Internet domain network via a service control point extension for the public switched telephone network and an SIP proxy server for an Internet domain network service provider (col. 27 ll. 61-col. 28 ll. 32 telecommunications network server as SCP; col. 42 ll. 57-col. 43 ll. 13 also using SIP);

b) detecting an attempted public switched telephone network (public switched telephone network) call within the public switched telephone network (col. 33 ll. 58-col. 34 ll. 13 call from the caller with destination identifier);

c) upon detection of the attempted public switched telephone network call, having the public switched telephone network inform the Internet domain network service provider (col. 34 ll. 4-13 message to telecommunication hosting server 203) to provide a

message reporting details of the attempted call in real time to the callee of the public switched telephone network call via an Internet protocol (Figs 3-4; col. 34 ll. 13-23 to provide a message that reports details of the attempted call to the callee via the internet network col. 27 ll. 18-20 IP-based connectionless network interface to Internet 200 to a user agent col. 34 ll. 24-col. 35 ll. 40; col. 51 ll. 11-41 sending Instant Message to the callee) (Figs. 3-5, 7-8, 11-12 and their descriptions).

6. Claims 1-3, 6-9, 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Zafar (US Patent No. 7,142,646 B2).

**Regarding claim 1**, Zafar teaches of a method of providing communication between a telephone caller and a callee of the telephone call, comprising:

a) linking a switched telephone network with an internet network via a telephone network/internet domain network interface (Fig. 1 item 106 linking items 102 and 104);

b) detecting an attempted call within the switched telephone network (col. 11 ll. 34-44);

c) upon detection of the attempted call, having the switched telephone network inform the telephone network/internet domain network interface to provide a message reporting details of the attempted call to the callee via the internet network (col. 11 ll. 34-50 notifying voice mail notification server and transmitting IM message).

**Regarding claim 2**, Zafar teaches of the method, wherein the switched telephone network is a public switched telephone network (Fig. 1 item 104).

**Regarding claim 3**, Zafar teaches of the method, wherein the internet network is the public Internet (Fig. 1 item 102).

**Regarding claim 6**, Zafar teaches of the method, wherein the callee informs at least **one of the public switched telephone network or the Internet domain network interface** to provide the message to the callee in real time via an Internet protocol when the attempted call is intended for the telephone number of the callee (Fig. 3; providing contact information where callee can be reached including IM; Fig. 3; storing contact information where callee can be reached including IM; the storage is part of database accessible to telephone network).

**Regarding claim 7**, Zafar teaches of the method, wherein the message details at least **one of the telephone number trying to reach the callee, the caller identification of the telephone number trying to reach the callee (caller ID), and the time of the attempted call (time and date)** (col. 11 ll. 50-65).

**Regarding claim 8**, Zafar teaches of the method, wherein the message is an Instant Message provided in real time (col. 11 ll. 50-65 sending Instant Message to the callee).

**Regarding claim 9**, Zafar teaches of the method, wherein the message is a text message (col. 51 ll. 11-41 col. 11 ll. 50-65 sending Instant Message to the callee).

**Regarding claim 12**, Zafar teaches of a method of providing crossover services, between an internet domain and a switched telephone network domain comprising the steps of:



a) starting an IM agent for a callee on an Internet-capable device to express interest in receiving notifications of incoming calls on a telephone line of the callee (Fig. 3; providing contact information where callee can be reached including IM);

b) having the IM agent register the interest of the callee with the telephone network (Fig. 3; storing contact information where callee can be reached including IM; the storage is part of database accessible to telephone network);

c) having the telephone network authenticate the IM agent and register the Internet address of the IM agent and the interest of the callee (col. 4 ll. 49-61 user identifier and password in service center; col. 5 ll. 5-23 using IM i.e. AIM to communicate with service center; Fig. 3; storing contact information where callee can be reached including IM; the storage is part of database accessible to telephone network);

d) having the telephone network undertake appropriate actions to ensure that incoming calls to the callee telephone line result in a notification action (col.10 ll. 51-64 setting triggers in SSPs);

e) executing the actions in step d) a when a caller on another line calls the callee telephone line by capturing the incoming call information and creating an Instant Message out of the incoming call information (col. 11 ll. 34-65 time, date, caller-id);

f) routing the Instant Message through the Internet to the Internet address of the IM agent of the callee registered in step c) (col. 11 ll. 34-65 transmitting voice mail using IM); and

g) displaying the Instant Message on an Internet -capable device for the consumption of the callee (col. 11 ll. 34-65 displaying IM).

**Regarding claim 13**, Zafar teaches of a method of providing crossover services, between an internet domain and a switched telephone network domain comprising the steps of:

a) starting an IM agent for a caller on an Internet -capable device to express interest in providing outgoing call notifications of the caller to the callee or other designated phone lines (Fig. 3; providing contact information where callee can be reached including IM);

b) having the IM agent register the preference of the caller with the telephone network to inform callees about an attempt by the caller to call the callee **or** any of the designated telephone lines (Fig. 3; storing contact information where callee can be reached including IM; the storage is part of database accessible to telephone network),

c) having the telephone network authenticate the IM agent and register the Internet address of the IM agent and the preferences of the caller (col. 4 ll. 49-61 user identifier and password in service center; col. 5 ll. 5-23 using IM i.e. AIM to communicate with service center; Fig. 3; storing contact information where callee can be reached including IM; the storage is part of database accessible to telephone network);

d) having the telephone network undertake appropriate actions to ensure that outgoing calls to the callee or designated telephone lines identified in step b) result in a notification action to the callee list when a telephone network service failure is detected

within the telephone network (col.10 ll. 51-64 setting triggers in SSPs; routing to voice mail on failure to provide call completion service to caller);

e) executing the actions in Step d) when a telephone network interruption/service failure is detected within the telephone network including having the telephone network capture the incoming call information (col. 11 ll. 34-65 time, date, caller-id) and

f) creating a message out of the incoming call information (col. 11 ll. 34-65 IM message with voice mail information);

g) routing the message through the Internet to the Internet address of the IM agent of the callee or designated telephone lines registered in step c) (col. 11 ll. 34-65 transmitting voice mail using IM); and

h) displaying the message in Internet-capable devices of the callee, or of persons on the list of designated telephone lines (col. 11 ll. 34-65 displaying IM).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamb as applied to claim 4 above, and further in view of Adamczyk (US Patent No. 7,283,620 B2).

**Regarding claim 5**, Lamb teaches of the method wherein the telephone network/internet domain network interface provides the message via an Internet protocol to the callee of the public switched telephone network call.

Lamb does not teach of providing this message to a caller-selected list of recipients.

However, in the same field of endeavor, Adamczyk teaches of a method wherein an instant message, for caller's voicemail for unanswered call to the callee, is provided to the caller specified list of recipients (col. 7 ll. 7-21, col. 7 ll. 59-col. 8 ll. 14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Lamb to provide instant message notifications to caller specified recipients as taught by Adamczyk "for originating and sending voice mail message to an instant messaging platform" (Adamczyk, col. 1, ll. 50-52) to inform multiple recipients simultaneously.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication No. 2003/0174815	Didcock
US Patent Application Publication No. 2003/0174814	Diacakis
US Patent No. 6,707,890	Gao
US Patent No. 6,351,464	Galvin
US Patent No. 6,459,913	Cloutier
US Patent No. 4,926,462	Ladd
US Patent No. 5,557,659	Hyde-Thomson
US Patent Application Publication No. 2002/0165000	Fok
US Patent No. 6,574,480	Foladare

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEMANT PATEL whose telephone number is (571)272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fan Tsang/  
Supervisory Patent Examiner, Art Unit 2614

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